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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,100	03/11/2004	G. Ronald Morris	73269/5	6052
1912 7590 06/05/2007 AMSTER, ROTHSTEIN & EBENSTEIN LLP 90 PARK AVENUE NEW YORK, NY 10016				
			EXAMINER ROZANSKI, MICHAEL T	
			ART UNIT 3768	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/798,100

Applicant(s)

MORRIS ET AL.

Examiner

Michael Rozanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 13-16, 22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12, 17-21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/11/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 7-12, 17-21, and 23 in the reply filed on 4/26/07 is acknowledged. Claims 1-6, 13-16, 22, and 24 are not examined.

### *Claim Objections*

2. Claims 17 and 18 are objected to because of the following informalities:  
-The claims make references to "said patient" and "said portion of the body", which inferentially claims a part of the human body. In a method claim, this could be overcome by referring to "the portion of the body of the patient" in each instance.  
Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7, 17, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by *Holland et al* (US 5,2099,233).

**Claims 7, 17, 21, and 23:** Holland et al disclose an apparatus for measuring motion of a portion of the body of a patient and an ECG of a patient in a magnetic field including a first and second electrode attached to a patient, first and second ECG leads

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connected to first and second electrodes, respectively, one of which encloses a part of the body of the patient, and an output voltage that is measured from the ECG used to represent motion of the body of the patient (col. 3, line 55-col. 4, line 64; see figure 2).

5. Claims 7, 8, 10, 11, 17, 18, 20, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by *Morris, Sr. et al* (US 6,148,229).

**Claims 7, 8, 10, 11, 17, 18, 20, 21, and 23:** Morris, Sr. et al disclose a system and method for measuring motion of a portion of the body of a patient and an electrocardiogram of a patient in a magnetic field including a first and second electrode 40 attached to a patient, first and second high resistance ECG leads 50 connected to first and second electrodes, respectively, one of which encloses a part of the body of the patient, and a voltage measuring device incorporated into a Faraday shield 55 (col. 4, line 35-col. 5, line 7). A cradle 70 is coupled around at least a part of the portion of the body of the patient coupled to one of the ECG leads (col. 4, line 53-col. 5, line 3).

Morris, Sr. et al also disclose all features including a Faraday shield 55, two RF filters 120 mounted in the shield, each having an input coupled to a respective ECG lead and an output, a differential amplifier 140 mounted in enclosure with its inputs coupled to respective output of one of the RF filters, a gradient filter 190 (i.e. averaging filter) coupled to output of differential amplifier, and a transmitter 160 having an output representative of the motion of a portion of the body (col. 4, line 53-col. 5, line 3; see figure 2).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Morris, Sr. et al*** in view of ***Imran*** (US 5,327,888).

***Claims 9 and 19:*** Morris, Sr. et al substantially disclose all features of the current invention including two primary field coils 70 that function to cradle a part of the body (see figure 1), but do not disclose a cradle formed from a thin polycarbonate plastic strip. In the same field of endeavor, Imran teaches a cradle for ECG purposes comprising thin polycarbonate plastic material (col. 2, lines 14-37). It would have been obvious to one with ordinary skill in the art at the time the invention was made to have incorporated this teaching in order to have a cradle that is made of temperature resistant material.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over ***Morris, Sr. et al*** in view of ***Stocklin*** (US 5,193,108).

***Claim 12:*** Morris, Sr. et al disclose all features including a Faraday shield 55, two RF filters 120 mounted in the shield, each having an input coupled to a respective ECG lead and an output, a differential amplifier 140 mounted in enclosure with its inputs coupled to respective output of one of the RF filters, a gradient filter 190 (i.e. averaging

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filter) coupled to output of differential amplifier, and a transmitter 160 having an output representative of the motion of a portion of the body (col. 4, line 53-col. 5, line 3; see figure 2). Morris, Sr. et al do not disclose one input of the differential amplifier coupled to the Faraday shield. In the same field of endeavor, Skocklin teaches of coupling of an input of a differential amplifier to a Faraday shield (col. 2, lines 3-13). It would have been obvious to one with ordinary skill in the art at the time the invention was made to have incorporated this teaching in order to obtain a desired input into the second input of the differential amplifier.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Rozanski whose telephone number is 571-272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571-272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
ELENI MANTIS MERCADER  
SUPERVISORY PATENT EXAMINER

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*MR*

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